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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KENNETH L. NASH P.O. BOX 680106 HOUSTON, TX 77268-0106				
EXAMINER				
BEATCH, THOMAS A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,358

Applicant(s)

SUNDARARAJAN ET AL.

Examiner

THOMAS A. BEACH

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 24-28 is/are allowed.
- 6) ☒ Claim(s) 29 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dare et al 4,215,749 alone. Dare shows lightweight subsea intervention package for use in servicing a subsea well, said subsea well comprising at least one of a vertical Christmas tree or a horizontal Christmas tree, said subsea intervention package being operable for containing said subsea well while using at least one of tubing, coiled tubing, or wireline during said servicing of said subsea wells, said subsea intervention package having a lower package 14 attachable to said subsea well regardless of whether said subsea well comprises said vertical Christmas tree or said horizontal Christmas tree, said lower package comprising at least two hydraulically actuated gate valves 52 (fig 1), at least one of said at least two hydraulically actuated gate valves being operable for cutting 90 said tubing (fig 2-3), coiled tubing, or wireline and then closing to form a seal for sealing said subsea well, at least one of said at least two hydraulically actuated gate valves is operable for repeated severing of tubulars of at least 2 ¾ inches without need for maintenance, said lower package weighs between ten and thirty tons, and said lower package defining a bore through said at least two hydraulically actuated gate valves (fig

1-3). Dare does not disclose the specific dimensions and weight of claim 29 including two hydraulically actuated gate valves which is greater than seven inches, tubulars of at least 2 ¾ inches or lower package weighs between ten and thirty tons; however, it would have been an obvious matter of design choice to modify the Dare to include the ranges of since applicant has not disclosed that these ranges solve any particular problem or purpose and it appears other similar ranges would work equally well. Furthermore, routine experimentation would lead one of ordinary skill in the art to these ranges.

Allowable Subject Matter

2. Claims 1-13 and 24-28 are allowed.
3. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 11/04/08 have been fully considered but they are not persuasive. Applicant's arguments regarding Dare not showing a lower package attachable to subsea well "regardless of whether said subsea well comprises a vertical Christmas tree or horizontal" are noted. They are not persuasive since they amount to functional language that does not result in a patentable distinction. This recitation of the intended use of the claimed invention must result in a structural difference between the

claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant's arguments regarding the "long term failure of the art" to disclose dimension and weights of elements are not based in fact since no evidence has been presented. The increase of a pipe tubular from 2" to 2 3/4" is not dramatic as applicant has argued. Furthermore, Dare describes a 2" tubular by way of example, ("such as"), but does not state anywhere in the patent that a slightly larger tubular cannot be utilized, or that this apparatus is only limited to this size.

Applicant's arguments noted KSR are noted; however, mere routine skill in the art would be able to have the opening (which appears to be able to handle a 2 3/4" tubular, see figure 6) and cutter function with these weight and dimension limitations.

Applicant's 4th argument regarding Dare not being capable of cutting tubing other than "macaroni" is inaccurate since Dare specifically states that it can and is used to cut "large diameter tubing 46" in columns 4 & 5, lines 66-67 & 1-2, respectively.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit: 3671

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Thomas A. Beach

/Thomas A Beach/
Primary Examiner, Art Unit 3671

February 3, 2009

THOMAS A. BEACH
Primary Examiner
Group 3600